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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/776,412 | 02/02/2001 | R. Steven Schultz | 01153.0001U2 | 4078 |

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NEEDLE & ROSENBERG, P.C.
SUITE 1000
999 PEACHTREE STREET
ATLANTA, GA 30309-3915

EXAMINER

HAVAN, THU THAO

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| ART UNIT | PAPER NUMBER |
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3624

DATE MAILED: 05/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/776,412

Applicant(s)

SCHULTZ ET AL.

Examiner

Thu Thao Havan

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 March 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>11/9/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Claims 17-40 are pending. This action is in response to the amendment received February 27, 2006.

Response to Arguments

The rejection of claims 17-40 under 35 U.S.C. 102(e) as being anticipated by Herman et al. (US patent no. 6,341,353) is maintained.

Applicant's arguments filed February 27, 2006 have been fully considered but they are not persuasive.

In response to the arguments concerning the previously rejected claims the following comments are made:

Applicant alleges that the prior art made of record fails to teach a hyperlink associated with a product return procedure. The examiner disagrees with applicant's representative since Herman teaches a hyperlink associated with a product return procedure (col. 39, lines 8-59). Herman discloses the relationship marketing server uses smart receipts as the basis for after-market consumer care. When a consumer buys a product, the merchants relationship marketing server generates a unique digital object in the form of a smart receipt which contains all of the information needed for consumer care. The relationship marketing server sends this information to the customer's trusted agent. The customer can open his trusted agent using a URL (*i.e. a type of hyperlink*), click on the smart receipt, and be presented with a number of

services, such as automatically routed requests for customer service or return authorizations (*i.e. a type of product return procedure*), number listings to call for help, order status tracking (for example, offered in eventual partnership with such shipping companies as Federal Express or UPS), and pre-formatted and routed requests for related product offers.

With regards to the claims rejected as taught by Herman, the examiner would like to point out that the reference teaches the claimed limitations and thus provides adequate support for the claimed limitations. Therefore, the examiner maintains that Herman taught the claimed limitations.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims **17-40** are rejected under 35 U.S.C. 102(e) as being anticipated by Herman et al. (US patent no. 6,341,353).

Re claims **17, 24, 28, and 32**, Herman teaches a method for providing an electronic receipt using an electronic receipt generator (figs. 19 and 22), comprising the steps of:

a. conducting a sales transaction between a buyer and a seller (col. 22, lines 18-24; fig. 4 discloses consumer/user corresponds to a buyer and a merchant/vendor corresponds to a seller);

b. generating by the electronic receipt generator an electronic receipt including detailed information describing the sales transaction, wherein the detailed information includes sale price, total transaction amount, item description (fig. 22), information indicating completion of the transaction (col. 1, lines 63-66), and a hyperlink associated with a product return procedure (col. 2, lines 11-14);

c. transmitting the receipt via a computer network to a computing device operated by the buyer (figs. 1 and 9);

d. displaying the detailed information on the computing device (col. 6, lines 41-54; fig. 9);

e. activating, by the buyer, the hyperlink on the computing device (col. 4, lines 16-36; fig. 1; abstract);

f. transmitting, to the computing device and in response to activation of the hyperlink, return information containing steps for returning the product (col. 43, line 4 to col. 44, line 37; figs. 16-17 and 19); and

g. displaying the return information on the computing device (fig. 18). *In other words, Herman discloses a smart electronic receipt system wherein a buyer and seller conducting sales transaction and receiving a receipt upon completion of the transaction. His system includes hyperlinks embedded in the Smart Receipt that enable the customer to access customer service and order status. The merchant may also embed*

additional services within the Smart Receipt, including special offers for future purchases.

Re claims **18, 20, and 40**, Herman teaches a.) requesting, by the user, a return shipping label for the product pursuant to a step for returning the product, b.) transmitting the return shipping label to the computing device, and c.) producing a hard copy of the return shipping label using the computing device (col. 38, lines 8-24).
Herman discloses a returning product includes either through a link to redemption at an online commerce site or by being printed on paper.

Re claims **19, 21-22, 25-26, and 29-30**, Herman teaches a.) requesting, by the buyer, warranty service information pursuant to a step for returning the product, b.) transmitting, to the computing device, steps for obtaining warranty service for the product, and c.) displaying the steps for obtaining warranty service on the computing device (col. 37, lines 25-35; col. 4, lines 16-36; col. 44, lines 53-55; fig. 1).

Re claims **23, 27, 31, 33, and 35-36**, Herman teaches a.) conducting a sales transaction between a buyer and a seller at a location associated with the seller (col. 22, lines 18-24; fig. 4 discloses consumer/user corresponds to a buyer and a merchant/vendor corresponds to a seller), b.) issuing a paper receipt to the buyer using a computing device operated by the seller (col. 38, lines 21-24; col. 39, lines 42-43; col. 41, lines 9-22), and c.) transmitting information about the sales transaction over the Internet to the electronic receipt generator, wherein the electronic receipt generator is operated by a third party (col. 11, lines 1-16; col. 13, lines 9-25).

Re claim **34**, Herman teaches second network is a wireless network operating at the location associated with the seller (col. 4, lines 7-26). Herman discloses a general Internet service provider.

Re claim **37**, Herman teaches first network is the Internet (fig. 2 (element 60)).

Re claim **38**, Herman teaches second networks are the same (figs. 1-3).

Re claim **39**, Herman teaches first network is one of a Local Area Network, a Wide Area Network, or the Internet (figs. 11 and 1-3).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thu Thao Havan whose telephone number is (571) 272-8111. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct-uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

TTH
5/9/2006



VINCENT MILLIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600